

REMARKS

In accordance with the foregoing, claims 1, 4-8, 12, and 15-19 are amended. No new matter is added. Claims 1-22 are pending and under consideration.

ALLOWABLE SUBJECT MATTER

Claims 5-7 and 16-18 are objected to but are indicated to be allowable if rewritten in independent form including all the limitations of the respective base and any intervening claims. Applicants acknowledge with appreciation the indication of allowable subject matter. However, since Applicant considers that claims 4 and 15, from which claims 5-7 and 16-18 respectively depend, define patentable subject matter, claims 5-7 and 16-18 are maintained in dependent form at the present time.

INTERVIEW WITH EXAMINERS

Applicant acknowledges with appreciation the courtesy of an interview granted to Applicant's representative on August 23, 2007, at which time the outstanding issues in this case were discussed. Arguments similar to the ones developed hereinafter were presented and the Examiner indicated that he would reconsider the outstanding grounds for rejection upon formal submission of a response.

CLAIM REJECTION UNDER 35 U.S.C. §102(e)

Claims 1-4, 8, 8, 9, 12-15, 19, and 20 are rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent No. 6,397,000 to Hatanaka et al. ("Hatanaka").

Claim 1 is amended herewith to clarify that "the image recording apparatus functions in at least two modes, a first mode in which the given signal is recorded/reproduced on the recording medium, and a second mode in which the given signal is not recorded/reproduced on the recording medium but is output" and "switching between the first mode and the second mode is determined by a remote controller." The claim amendments are fully supported by the originally filed specification, for example FIG. 6 and page 15, lines 22-36.

Hatanaka also fails to anticipate "a coding/decoding part performing **coding and decoding a digital signal** in one of a plurality of coding/decoding modes of different bit rates" (emphasis ours) as recited in amended claim 1.

Hatanaka discloses three **recording** modes SP, EP and LP (see lines 37-44 in col. 8 of Hatanaka). Two of the recording modes (SP and EP) refer to analogue recording standard VHS,

and only one mode (LP) refers to a digital signal. The modes disclosed in Hatanaka are separated by tape speed and not by bit rate as recited in claim 1. Alleging that disclosure of different recording modes anticipates "coding and decoding a digital signal in one of a plurality of coding/decoding modes of different bit rates" is not justified given that claim 1 explicitly excludes recording, "the digital signal [being] output after being coded and decoded by said coding/decoding part without storage thereof in said recording medium" (emphasis ours).

Since Hatanaka art fails to teach or suggest every feature recited in claim 1, claim 1 and claims 2 and 3 depending from claim 1 are patentably distinct over the prior art.¹

Independent claim 4 is amended herewith to specify that the "control part automatically setting a bit rate corresponding to one of the plurality of coding/decoding modes to be applied by said coding/decoding part according to at least a remaining storage capacity A (bytes) of said recording medium." Claim 4's amendments are fully supported by the originally filed specification, for example, original claims 5-7. Applicant believes that the claim amendment renders independent claim 4 patentable over the prior art. Claims 5-7, which were indicated as allowable are amended to correlate the recitations with amended claim 4. No new matter is added.

Claim 8 is amended similar to claim 1. Amended claim 8 and claims 9-11 depending from claim 8 patentably distinguish over Hatanaka at least because the prior art does not anticipate the following recitation of claim 8:

the image recording apparatus functions in at least two modes, a first mode in which the given signal is recorded/reproduced on the recording medium, and a second mode in which the given signal is not recorded/reproduced on the recording medium but is output, and switching between the first mode and the second mode is determined by a remote controller.

Claim 12 is amended similar to claim 1. Amended claim 12 and claims 13 and 14 depending from claim 12 patentably distinguish over Hatanaka at least because the prior art does not anticipate the following recitation of claim 12:

wherein the semiconductor device functions in at least two modes, a first mode in which the given signal is recorded/reproduced on the recording medium, and a second mode in which the given signal is not recorded/reproduced on the recording medium but is output, and switching between the first mode and the second

¹ See MPEP 2131: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," (Citations omitted) (emphasis added). See also MPEP 2143.03: "All words in a claim must be considered in judging the patentability of that claim against the prior art."

mode is determined by a remote controller.

Independent claim 15 is amended herewith to specify that the "control part automatically [sets] a bit rate corresponding to one of the plurality of coding/decoding modes to be applied by said coding/decoding part according to at least a remaining storage capacity A (bytes) of a recording medium in which the given signal is recorded." Claim 15's amendments are fully supported by the originally filed specification, for example, original claims 16-18. Applicant believes that the claim amendment renders independent claim 15 patentable over the prior art. Claims 16-18, which were indicated as allowable are amended to correlate the recitations with amended claim 15. No new matter is added.

Claim 19 is amended similar to claim 1. Amended claim 19 and claims 20-22 depending from claim 19 patentably distinguish over Hatanaka at least because the prior art does not anticipate the following recitation of claim 19:

the semiconductor device functions in at least two modes, a first mode in which the given signal is recorded/reproduced on the recording medium, and a second mode in which the given signal is not recorded/reproduced on the recording medium but is output, and switching between the first mode and the second mode is determined by a remote controller.

CLAIM REJECTIONS UNDER 35 U.S.C. § 103(a)

Claims 10, 11, 21, and 22 are rejected as 35 U.S.C. §103(a) as allegedly unpatentable over Hatanaka in view of U.S. Patent Application Publication No. 2003/0120942 to Yoshida et al. ("Yoshida").

Yoshida does not correct or compensate for the above identified failure of Hatanaka in anticipating all the features of the independent claims. Therefore, claims 10, 11, 21, and 22 patentably distinguish over the prior art at least by inheriting patentable features from the independent claims.

CONCLUSION

It is respectfully submitted that the foregoing has patentably distinguished the pending claims over the references and rejections of record. Further, all outstanding objections have been overcome by the foregoing. There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

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If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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